

**REMARKS**

The Office Action dated March 19, 2008 has been reviewed and carefully considered. Claims 1-25 remain pending herein. Claims 14 and 25 have each been amended to include the limitations of their respective base claim and any intervening claims. Consequently, claims 1, 14, 18 and 25 are the only independent claims. Request for reconsideration and allowance of all the pending claims are respectfully requested in light of the amendments and following remarks.

Claims 6, 8 and 25 stand rejected under 35 U.S.C. §112, second paragraph. In response applicants have amended each of these claims as well as claim 5 so that they conform to 35 U.S.C. §112. Accordingly, applicants respectfully request that the rejections be withdrawn.

Applicants note with appreciation the indication that claims 14 and 25 would be allowable if rewritten so as not to depend from a rejected claim, and with no change in scope. Since these claims have been so rewritten, they are now believed to be in condition for allowance.

Claims 1-13 and 15-18 and 21-23 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatenable over Moseley et al., U.S. Pat. No. 6,437,915 (hereinafter Moseley) in view of Margerum et al., U.S. Pat. No. 5,099,343, (hereinafter, Margerum). Claims 18-20 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Margerum. Claim 24 stands rejected under 35 U.S.C. §103(a) as allegedly being

unpatenable over Moseley in view of Margerum, in further view of Tomomo, U.S. Pub. No. 2003/0067563.

Applicant respectfully disagrees with, and explicitly traverses, the Examiner's reasons for rejecting the claims. A claimed invention is prima facie obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

With regard to claim 1, this claim recites:

1. A waveguide (9, 18, 35, 38) for use in illuminating a display panel (2), comprising:
  - a first face (13) arranged to receive light from a light source (3); and
  - an exit face (15) through which light may exit the waveguide;configured so that, in use, light enters the waveguide (9, 18, 35, 38) through said first face, is scattered by a plurality of portions of diffusing material (10a to 10f, 19a to 19g) located within the waveguide (9, 18, 35, 38) and leaves the waveguide (9, 18, 35, 38) through said exit face (15); thereby illuminating the display panel.

As indicated by the underlined section above, claim 1 has been amended to more clearly state that the waveguide is used to illuminate a display panel (as indicated in the

original preamble as well). That is, the waveguide, and the illumination it provides, is distinct from the display panel. This aspect of the invention is clearly depicted in Fig. 2 and described further *inter alia* in paragraph [0035] of the published application which states:

In this example, the display panel 2 comprises a layer of electro-optically active material, such as a liquid crystal material, sandwiched between two light-transmissive substrates (not shown). In the case of a liquid crystal layer, the operation of the layer may be based on, for example, a twisted nematic (TN), super-twisted nematic (STN), vertically aligned nematic (VAN), optically compensated birefringence (OCB), in-plane switching nematics (IPS) or ferro-electric effect for modulating a polarisation direction of incident light. The display panel 2 is subdivided into an array of pixels and is provided with an active matrix or a passive matrix arrangement (not shown) for driving the pixels to allow an image to be displayed in a manner well known per se.

As so described, the display interacts with the received light to generate an image. This light is provided by a waveguide. This dichotomy of the display panel and the waveguide generating light are recited in claim 1.

In Paragraph 5 of the Office Action, the Examiner acknowledges that Moseley fails to teach the feature of claim 1 wherein “the waveguide having a first face for receiving light and an exit face therefore in which the light leaves after it is scattered by a plurality of portions of diffusing material located within the waveguide.” The Examiner then points to Fig. 3 (and items 22-26 therein) of Margerum as teaching this feature. Applicants respectfully disagree.

Fig. 3 of Margerum depicts “on segments” (item 24) and “off segments” (item 22) on a PDLC film (item 16) which are illuminated by a light source 34. Paragraph 5 of the Office Action argues that items 22-26 are “diffusing material within the waveguide.” Applicants submit that items 22-26 are in fact the display device itself (as clearly illustrated in Fig. 3) and that Margerum fails to teach or suggest the waveguide (which supplies illumination to the display panel) contains “a plurality of portions of diffusing material located within the waveguide” as recited in claim 1.

Having shown that the combined device resulting from the teachings of the cited references does not include all the elements of the present invention, Applicant submits that the reasons for the Examiner’s rejection of claim 1 has been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of this claim.

In the matter of obviousness there is a great emphasis placed on “the importance of the motivation to combine.” For example, the court in Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc. 231 F. 3d. 1339, 56 USPQ2d. 1641, 1644 (Fed. Cir. 2000) found that:

an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to

defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *id.* quoting *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

In this case, Applicant believes that with regard to the referred-to claims, the Examiner has impermissibly incorporated the teachings of the present invention in the cited reference to reject the claims. Accordingly, Applicant submits that the reasons for the Examiner's rejections of the claims have been overcome and the rejection can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness, instant independent claim 1 is allowable, and the rejection should be withdrawn.

In a manner analogous to claim 1, claim 18 has been amended to more clearly indicate that the use of providing a waveguide to illuminate a display panel is a separate step to that of the actual displaying of an image on a display panel. The Office Action relies on the Margerum reference as teaching "a waveguide 12 comprising a layer of diffusive material 16 in which a power source 28 sets the optical properties of at least one portion 22 of layer 16 to meet claim 18" (quoting paragraph 10 of the Office Action). Applicants respectfully disagree. As discussed above with respect to claim 1,

Applications submit that Margerum merely depicts the presence of diffusive material in the display panel itself – not in a waveguide that illuminates the display panel. For at least this reason, both the rejection under 35 U.S.C. §102 and under §103 fail as the stated reference does not include all the elements of claim 18. Accordingly, claim 18 is allowable and the rejections should be withdrawn.

Claims 2-13, 15-17 and 19-24 are dependent from one of the independent claims discussed above, and are believed allowable for at least the same reasons and any rejections thereof should be withdrawn.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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